

REMARKS

After entry of this amendment, claims 1-16 and 18-20 are pending. Claims 1-12, 15 and 18 have been amended without prejudice or disclaimer to better comply with the U.S. practice and find support *inter alia* in the original claims or claims as previously presented. Further support for the amendments made to claims 2, 3, 8 is found in the specification at page 11, line 33 through page 13, line 21, and page 10, lines 33-44. Support for parts ii) and iii) of claims 2, 3, 8 is found at page 10, lines 36-44. New claims 19 and 20 find support in part c) of original claim 1 and part c) of original claim 7, respectively. No new matter has been added.

In response to the restriction requirement set forth in the Office Action mailed April 20, 2007, Applicants provisionally elect plant organisms and the sequence of SEQ ID NO: 1 with traverse. Reconsideration and withdrawal of the restriction requirement is strongly urged for the following reasons.

The Claimed Inventions Share a Special Technical Feature

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled “when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” (PCT Rule 13.2).

The Examiner argues that the inventions do not relate to a “special technical feature” which defines a contribution over the prior art, citing Conrad et al. (US Patent 6,403,371). Applicants respectfully disagree that the inventions of the present application do not make a contribution over the reference cited by the Examiner.

As stated in the specification and repeated in the claims, the general inventive concept of the present application relates to promoters and methods of identifying and using said promoters which have high specificity for carbohydrate-storing sink tissues of plants. See Specification at page 4, lines 36-40. As the Examiner correctly characterized, Conrad et al. discloses a seed-specific promoter and the use thereof. See Official Action at page 3. Conrad et al. does not disclose the promoters of the present invention, namely the sink tissue-specific promoters. See,

e.g., Specification at page 7, line 46 to page 8, line 8 (selective expression in carbohydrate-storing sink tissues, such as potato tuber and tomato fruit, while no discernible expression was detected in the seeds of oilseed rape or Arabidopsis). Therefore, Conrad et al. does not disclose the special common technical feature of the promoter with high specificity for sink tissues. The claims therefore should not be restricted to one of three promoter sequences.

Furthermore, the promoter sequences are closely related so examining them all together would not create an undue burden. The sequences share a common feature of promoter specificity for carbohydrate-storing sink tissues. Furthermore, as described in the specification at page 19 (lines 29-32) and 46 (lines 34-44), the promoter sequences shown in SEQ ID NOs: 2 and 3 are derived from the same gene, the *Vicia faba* Pho1 gene. More specifically, SEQ ID NO: 1 is the short version of SEQ ID NOs: 2 and 3. SEQ ID NOs: 2 and 3 have additional coding elements at the 5' end of the promoter of the *Vicia faba* Pho1 gene. See Specification at page 19, lines 29-32 and page 46, lines 34-44. For these reasons, Applicants respectfully request that the requirement for restriction to one promoter sequence be reconsidered and removed entirely.

Accordingly, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application.

Unity Of Invention Must Be Considered First Only In Relation To Independent Claims

As mentioned above and as explained in Chapter 10 of the PCT International Search and Preliminary Examination Guidelines, PCT Rules 13.1 and 13.2 are the applicable standard for determining unity of invention during the national stage of an international application under 35 U.S.C. § 371. See also MPEP § 1850. According to Chapter 10 §10.06 of these Guidelines, unity of invention must be “considered in the first place only in relation to the independent claims” and not the dependent claims. Furthermore, Chapter 10 §10.07 of the Guidelines states that “[i]f the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect to any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.”

The Examiner has required an election of one of the organisms. The organisms listed by the Examiner correspond to the organisms recited in a dependent claim (*i.e.* claim 13). As

explained above, the Patent Office has not established the presence of Applicants' special technical feature in the prior art. The inventions of all the claims thus share a common special technical feature. A requirement for a further election based on the species recited in a dependent claim is therefore improper under PCT Rules which govern in a national stage application. For at least this reason, Applicants respectfully request that the requirement for restriction to one organism be reconsidered and removed entirely. In the alternative, Applicants respectfully request that at least plant organisms be examined together with bacterial organisms as these are well-known to be used for generating transgenic plants and present the same issues as plant organisms.

The Examiner has further required an election of a single promoter sequence. Applicants disagree with this requirement and request reconsideration and withdrawal for essentially the same reason as discussed above. Namely, the specific sequence identifiers do not appear in independent claims 1 and 7, so these claims are not properly restricted to a feature in their dependent claims.

CONCLUSION

For at least the above reasons, Applicants respectfully request that the restriction requirement be reconsidered and withdrawn. Alternatively, Applicants respectfully request that at least SEQ ID NOs: 1, 2 and 3 be examined together, and that bacterial and plant organisms both be examined.

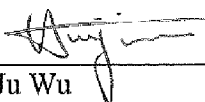
Applicants reserve all rights to pursue the non-elected species in one or more divisional application, if necessary.

Accompanying this response is a petition for a one-month extension of time to and including June 20, 2007 to respond to the Office Action mailed April 20, 2007 with the required fee authorization. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 13173-00008-US from which the undersigned is authorized to draw.

Respectfully submitted,

By

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